



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/419,246	10/15/1999	KENZO SEKIGUCHI	862.3071	9956

5514 7590 01/13/2006

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

POKRZYWA, JOSEPH R

ART UNIT	PAPER NUMBER
----------	--------------

2622

DATE MAILED: 01/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/419,246	Applicant(s) SEKIGUCHI ET AL.	
	Examiner Joseph R. Pokrzywa	Art Unit 2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-14, 21-28, 35, 45 and 50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-14, 21-28, 35, 45 and 50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's response was received on 9/27/05, and has been entered and made of record. Currently, **claims 7-14, 21-28, 35, 45, and 50** are pending.
2. Applicant's response filed 9/27/05 of a sworn translation of the Japanese priority patent application, with respect to the rejection(s) of claim(s) 7-14, 21-28, 35, 45, and 50 under 35 U.S.C. 102(e) as being anticipated by Mertama *et al.* (U.S. Patent Number 6,629,130), have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Sekiguchi (U.S. Patent Number 6,185,604).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 7-14, 21-28, 35, 45, and 50** are rejected under 35 U.S.C. 102(e) as being anticipated by Sekiguchi *et al.* (U.S. Patent Number 6,185,604)

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C.

Art Unit: 2622

102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

Regarding **claim 7**, Sekiguchi discloses a communication apparatus (e-mail/fax machine 1-11, seen in Figs. 1 and 11) for forming and outputting image data on the basis of data received via a network (LAN 1-7, column 3, lines 43-67), comprising a receiving unit adapted to receive data composed of a predetermined character code (column 7, line 3-column 8, line 16), an extracting unit adapted to analyze the data received by the receiving unit and to extract binary data encoded by the character code (column 8, line 16-column 9, line 25), and a converting unit adapted to convert the binary data extracted by the extracting unit into image data (column 4, line 30-column 5, line 52), a first determining unit adapted to determine, during a receiving session by the receiving unit, whether the binary data is convertible into image data (column 10, line 19-column 11, line 15, see Figs. 2A and 2B), and a first informing unit adapted to inform a source of the received data of the determination result from the first determining unit during the receiving session (column 10, line 19-column 11, line 15), wherein the first determining unit and the first informing unit operate during the same receiving session (see Figs. 2A and 2B, and column 10, line 19-column 11, line 15).

Regarding **claim 8**, Sekiguchi discloses the apparatus discussed above in claim 7, and further teaches that the receiving unit receives data by an electric mail protocol (column 5, line 53-column 6, line 62), and the first informing unit informs the source by using a response signal in the electric mail protocol (see Figs. 2A and 2B, and column 10, line 19-column 11, line 15).

Regarding **claim 9**, Sekiguchi discloses the apparatus discussed above in claim 7, and further teaches of a second informing unit adapted to transmit, if the second determining unit determines that the data is inconvertible, a message concerning the information transmitted by the first informing unit in another session after the receiving session is completed (column 11, lines 1-15).

Regarding **claim 10**, Sekiguchi discloses the apparatus discussed above in claim 9, and further teaches of a second determining unit adapted to determine a language type of the source of the received binary data, which is extracted from a character data portion other than the binary data (column 5, line 53-column 6, line 62), wherein the second informing unit transmits a message corresponding to the language type determined by the second determining unit (column 10, line 19-column 11, line 15).

Regarding **claim 11**, Sekiguchi discloses the apparatus discussed above in claim 7, and further teaches of a third determining unit adapted to transmit, during the receiving session by the receiving unit, whether the binary data encoded by the character code can be decoded (column 10, line 19-column 11, line 15), wherein the first informing unit informs the source of the received data of the determination result from the third determining unit during the receiving session (see Figs. 2A and 2B, and column 10, line 19-column 11, line 15).

Regarding **claim 12**, Sekiguchi discloses the apparatus discussed above in claim 11, and further teaches that the receiving unit receives data by an electric mail protocol (column 5, line 53-column 6, line 62), and the first informing unit informs by using a response signal in the electric mail protocol (see Figs. 2A and 2B, and column 5, line 53-column 6, line 62).

Regarding *claim 13*, Sekiguchi discloses the apparatus discussed above in claim 11, and further teaches of a third informing unit adapted to transmit, if the third determining unit determines that the data is inconvertible, a message concerning the information transmitted by the first informing unit in another session after the receiving session is completed (column 11, lines 1-15).

Regarding *claim 14*, Sekiguchi discloses the apparatus discussed above in claim 13, and further teaches of a language determining unit adapted to determine a language type of the source of the received binary data, which is extracted from a character data portion other than the binary data (column 10, line 19-column 11, line 15), wherein the third informing unit transmits a message corresponding to the language type determined by the language determining unit (see Figs. 2A and 2B, and column 10, line 19-column 11, line 15).

Regarding *claim 21*, Sekiguchi discloses a method for forming and outputting image data on the basis of data received via a network (LAN 1-7, column 3, lines 43-67), comprising the steps of receiving data composed of a predetermined character code (column 7, line 3-column 8, line 16), analyzing the received data and extracting binary data encoded by the character code (column 8, line 16-column 9, line 25), and converting the extracted binary data into image data (column 4, line 30-column 5, line 52), determining, during a receiving session in which the receiving step is performed, whether the binary data is convertible into image data, and outputting a second determination result (column 10, line 19-column 11, line 15, see Figs. 2A and 2B), and informing a source of the received data of the second determination result during the receiving session (column 10, line 19-column 11, line 15), wherein the determining step and

Art Unit: 2622

the informing step are performed during the same receiving session (see Figs. 2A and 2B, and column 10, line 19-column 11, line 15).

Regarding **claim 22**, Sekiguchi discloses the method discussed above in claim 21, and further teaches that the receiving step receives data by an electric mail protocol (column 5, line 53-column 6, line 62), and the second determination result is transmitted by using a response signal in the electric mail protocol (see Figs. 2A and 2B, and column 10, line 19-column 11, line 15).

Regarding **claim 23**, Sekiguchi discloses the method discussed above in claim 21, and further teaches of transmitting, if the second determining result indicates that the data is inconvertible, a message concerning the second determination result in another session after the receiving session is completed (column 11, lines 1-15).

Regarding **claim 24**, Sekiguchi discloses the method discussed above in claim 23, and further teaches of determining a language type of the source of the received binary data, which is extracted from a character data portion other than the binary data (column 5, line 53-column 6, line 62), wherein a message corresponding to the determined language type is transmitted in another session (column 10, line 19-column 11, line 15).

Regarding **claim 25**, Sekiguchi discloses the method discussed above in claim 21, and further teaches of determining, during the receiving session of the receiving step, whether the binary data encoded by the character code can be decoded, and outputting a third determination result (column 10, line 19-column 11, line 15), wherein the source of the received data is informed of the third determination result during the receiving session (see Figs. 2A and 2B, and column 10, line 19-column 11, line 15).

Regarding **claim 26**, Sekiguchi discloses the method discussed above in claim 25, and further teaches that the receiving step includes receiving data by an electric mail protocol (column 5, line 53-column 6, line 62), and the informing step includes informing the source by using a response signal in the electric mail protocol (see Figs. 2A and 2B, and column 5, line 53-column 6, line 62).

Regarding **claim 27**, Sekiguchi discloses the method discussed above in claim 25, and further teaches of transmitting, if the third determination result indicates that the data is inconvertible, a message concerning the third determination result in another session after the receiving session is completed (column 11, lines 1-15).

Regarding **claim 28**, Sekiguchi discloses the method discussed above in claim 27, and further teaches of determining a language type of the source of the received binary data, which is extracted from a character data portion other than the binary data (column 10, line 19-column 11, line 15), wherein a message corresponding to the determined language type is transmitted in another session (see Figs. 2A and 2B, and column 10, line 19-column 11, line 15).

Regarding **claim 35**, Sekiguchi discloses a storage medium storing a computer program to be executed by a computer of a communication apparatus (e-mail/fax machine 1-11, seen in Figs. 1 and 11, column 4, lines 1-12) for forming and outputting image data on the basis of data received via a network (LAN 1-7, column 3, lines 43-67), the computer program comprising the steps of receiving data composed of a predetermined character code (column 7, line 3-column 8, line 16), analyzing the received data and extracting binary data encoded by the character code (column 8, line 16-column 9, line 25), and converting the extracted binary data into image data (column 4, line 30-column 5, line 52), determining, during a receiving session in which the

Art Unit: 2622

receiving step is performed, whether the binary data is convertible into image data, and outputting a second determination result (column 10, line 19-column 11, line 15, see Figs. 2A and 2B), and informing a source of the received data of the second determination result during the receiving session (column 10, line 19-column 11, line 15), wherein the determining step and the informing step are performed during the same receiving session (see Figs. 2A and 2B, and column 10, line 19-column 11, line 15).

Regarding **claim 45**, Sekiguchi discloses a communication apparatus (e-mail/fax machine 1-11, seen in Figs. 1 and 11) comprising a receiving unit adapted to receive electronic mail (column 7, line 3-column 8, line 16), an extracting unit adapted to analyze the electronic mail received by the receiving unit and to extract binary data attached to the electronic mail (column 8, line 16-column 9, line 25), and a converting unit adapted to convert the binary data extracted by the extracting unit into image data (column 4, line 30-column 5, line 52), and an output unit adapted to output the image data converted by the converting unit (column 10, line 19-column 11, line 15), wherein if during a receiving session of the electronic mail, the converting unit detects that the binary data is inconvertible into image data (column 10, line 19-column 11, line 15, see Figs. 2A and 2B), a source of the electronic mail is informed of a conversion error during the same receiving session (see Figs. 2A and 2B, and column 10, line 19-column 11, line 15).

Regarding **claim 50**, Sekiguchi discloses a method of forming and outputting image data on the basis of received via a network (LAN 1-7, column 3, lines 43-67), comprising the steps of receiving electronic mail (column 7, line 3-column 8, line 16), analyzing the received electronic mail and extracting binary data attached to the electronic mail (column 8, line 16-column 9, line 25), and converting the extracted binary data into image data (column 4, line 30-column 5, line

Art Unit: 2622

52), and outputting the converted image data (column10, line 19-column 11, line 15), wherein if during a receiving session of the electronic mail, the binary data is found to be inconvertible into image data (column 10, line 19-column 11, line 15, see Figs. 2A and 2B), a source of the electronic mail is informed of a conversion error during the same receiving session (see Figs. 2A and 2B, and column10, line 19-column 11, line 15).

Citation of Pertinent Prior Art

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Turina (U.S. Patent Number 5,784,362) discloses a frame identification system in cellular packet data.

Conclusion

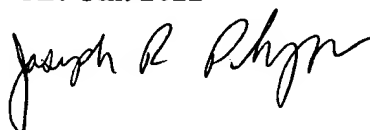
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (571) 272-7410. The examiner can normally be reached on Monday-Friday, 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2622

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Joseph R. Pokrzywa
Primary Examiner
Art Unit 2622

A handwritten signature in black ink, appearing to read "Joseph R. Pokrzywa", written in a cursive style.

jrj